

ESTTA Tracking number: **ESTTA439857**

Filing date: **11/07/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Blue Cross and Blue Shield Association
Granted to Date of previous extension	11/06/2011
Address	225 North Michigan Avenue Chicago, IL 60601 UNITED STATES
Attorney information	Garner K. Weng Hanson Bridgett LLP 425 Market Street San Francisco, CA 94105 UNITED STATES ttabfilings@hansonbridgett.com, gweng@hansonbridgett.com, soneill@hansonbridgett.com

Applicant Information

Application No	85004633	Publication date	05/10/2011
Opposition Filing Date	11/07/2011	Opposition Period Ends	11/06/2011
Applicant	The McGraw Company 3601 Haven Avenue Menlo Park, CA 94025 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Insurance services, namely, underwriting claims administration and agency services for casualty and watercraft insurance

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	557037	Application Date	12/15/1949
Registration Date	04/01/1952	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		

Design Mark	BLUE SHIELD
Description of Mark	NONE
Goods/Services	Class U100 (International Class 042). First use: First Use: 1939/09/23 First Use In Commerce: 1940/04/00 FURNISHING MEDICAL CARE ON A PRE-PAYMENT BASIS

U.S. Registration No.	557040	Application Date	11/13/1950
Registration Date	04/01/1952	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark	BLUE SHIELD		
Description of Mark	NONE		
Goods/Services	Class U102 (International Class 036). First use: First Use: 1939/09/23 First Use In Commerce: 1940/04/00 UNDERWRITING THE EXPENSE OF MEDICAL CARE		

U.S. Registration No.	1039941	Application Date	05/27/1975
Registration Date	05/18/1976	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1946/03/30 First Use In Commerce: 1946/03/30 INDICATING MEMBERSHIP IN APPLICANT		

U.S. Registration No.	1045586	Application Date	05/27/1975
Registration Date	08/03/1976	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		


Goods/Services	Class 036. First use: First Use: 1939/09/23 First Use In Commerce: 1940/04/15 PREPAID FINANCING AND ADMINISTRATION OF MEDICAL, HOSPITAL AND RELATED HEALTH SERVICES		
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U.S. Registration No.	1439564	Application Date	08/29/1985
Registration Date	05/12/1987	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1972/12/00 First Use In Commerce: 1972/12/00 HOME HEALTHCARE SERVICES, PREVENTIVE HEALTHCARE SERVICES, HEALTH CARE SERVICES RENDERED THROUGH A HEALTH MAINTENANCE ORGANIZATION, NAMELY PHYSICIAN SERVICES, DENTAL SERVICES, HOSPITAL SERVICES, HEALTH TREATMENT AND THERAPY SERVICES, DIAGNOSTIC TESTING AND EXAMINATION SERVICES, FAMILY PLANNING SERVICES, MENTAL HEALTH SERVICES NURSING SERVICES AND PRESCRIPTION DRUG SERVICES, AND ARRANGING FOR AMBULANCE SERVICES		

U.S. Registration No.	1510107	Application Date	04/01/1988
Registration Date	10/25/1988	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1939/09/23 First Use In Commerce: 1940/04/00 EDUCATIONAL BOOKS, BINDERS, PRINTED FORMS, BUSINESS FORMS, TRADE JOURNALS, NOTEBOOKS, WRITING PAPER, ENVELOPES, PENS AND PENCILS		

U.S. Registration No.	2016013	Application Date	01/21/1994
Registration Date	11/12/1996	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1996/01/01 First Use In Commerce: 1996/01/01 underwriting, financing, administration, and brokerage of life insurance		

U.S. Registration No.	3076417	Application Date	03/31/2005
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2005/02/01 First Use In Commerce: 2005/02/01 Offering consumer-driven health care plan, namely, underwriting, administration, financing, and maintenance of consumer-driven health care plans and defined contribution health care plans; debit card services, check cashing and check issuance, electronic debit transactions and electronic check processing transactions and providing financial information by electronic means via a global computer network, all of which are provided in connection with health care coverage plans


U.S. Registration No.	3076808	Application Date	06/30/2005
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 items of clothing and headgear, namely, t-shirts, shorts, sweatshirts, sweatpants, pullover tops, jackets, coats, socks, hats, caps and visors		

U.S. Registration No.	3076809	Application Date	06/30/2005
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		

Design Mark	BLUE SHIELD
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 pencils, pens, writing paper, envelopes, announcement cards, non-electric pencil sharpeners, drawing pads, paper identification tags, paper sheets, note pads, greeting cards, paperweights, stands for pencils and pens, calendars, diaries and stickers

U.S. Registration No.	3076810	Application Date	06/30/2005
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark	BLUE SHIELD		
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 stuffed toy animals		


U.S. Registration No.	3076812	Application Date	06/30/2005
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 021. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 coffee mugs and cups


U.S. Registration No.	3169932	Application Date	03/31/2005
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1997/04/01 First Use In Commerce: 1997/04/01 Administration, financial management and maintenance of health savings accounts, medical savings accounts, and flexible spending accounts; insurance claims administration		


U.S. Registration No.	3288737	Application Date	03/31/2005
Registration Date	09/04/2007	Foreign Priority Date	NONE
Word Mark	BLUE SHIELD		

Design Mark	Blue Shield
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2006/11/30 First Use In Commerce: 2006/11/30 Banking and financial services, namely, checking and savings account services, electronic funds transfer, cash management and disbursement services, lending services, acceptance of deposits and loan payments, check cashing and check issuance, electronic payment services, providing financial information by electronic means, providing secure financial transactions in the nature of electronic cash transactions, electronic check processing transactions, trustee services, investment security services, certificates of deposits, asset management services, stored-value card services, smart card services, credit card services, all of which are provided in connection with health care coverage plans


U.S. Registration No.	562430	Application Date	07/16/1951
Registration Date	07/29/1952	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U102 (International Class 036). First use: First Use: 1949/09/05 First Use In Commerce: 1949/09/05 UNDERWRITING, ON A PREPAYMENT BASIS, THE EXPENSE TO THE PATIENT OF MEDICAL CARE AND UNDERWRITING THE DOCTOR'S EXPENSE IN FURNISHING MEDICAL CARE		


U.S. Registration No.	591778	Application Date	10/06/1952
Registration Date	06/22/1954	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	NONE
Goods/Services	Class U102 (International Class 036). First use: First Use: 1947/10/00 First Use In Commerce: 1947/10/00 UNDERWRITING, ON A PREPAYMENT BASIS, THE EXPENSE TO THE PATIENT OF MEDICAL CARE AND UNDERWRITING THE DOCTOR'S EXPENSE IN FURNISHING MEDICAL CARE


U.S. Registration No.	617304	Application Date	07/21/1954
Registration Date	12/06/1955	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U102 (International Class 036). First use: First Use: 1947/10/00 First Use In Commerce: 1947/10/00 UNDERWRITING, ON A PREPAYMENT BASIS, THE EXPENSE TO THE PATIENT OF MEDICAL CARE AND UNDERWRITING THE DOCTOR'S EXPENSE IN FURNISHING MEDICAL CARE		


U.S. Registration No.	1039866	Application Date	05/27/1975
Registration Date	05/18/1976	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1973/07/24 First Use In Commerce: 1973/07/24 PREPAID FINANCING AND ADMINISTRATION OF MEDICAL, HOSPITAL AND RELATED HEALTH SERVICES


U.S. Registration No.	1039940	Application Date	05/27/1975
Registration Date	05/18/1976	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1973/07/24 First Use In Commerce: 1973/07/24 INDICATING MEMBERSHIP IN APPLICANT		


U.S. Registration No.	1319825	Application Date	08/01/1983
Registration Date	02/12/1985	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1969/06/01 First Use In Commerce: 1969/06/01 Prepaid Financing and Administration of Dental and Related Health Care Services


U.S. Registration No.	1423379	Application Date	08/29/1985
Registration Date	12/30/1986	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1972/12/00 First Use In Commerce: 1972/12/00 HOME HEALTHCARE SERVICES, PREVENTIVE HEALTHCARE SERVICES, HEALTH CARE SERVICES RENDERED THROUGH A HEALTH MAINTENANCE ORGANIZATION NAMELY PHYSICIAN SERVICES, DENTAL SERVICES, HOSPITAL SERVICES, HEALTH TREATMENT AND THERAPY SERVICES, DIAGNOSTIC TESTING AND EXAMINATION SERVICES, FAMILY PLANNING SERVICES, MENTAL HEALTH SERVICES, NURSING SERVICES AND PRESCRIPTION DRUG SERVICES, AND ARRANGING FOR AMBULANCE SERVICES		


U.S. Registration No.	1423707	Application Date	05/27/1986
Registration Date	01/06/1987	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1984/07/03 First Use In Commerce: 1984/07/03 A.M./F.M. STEREO RECEIVERS WITH HEADPHONES, CASSETTE TAPE PLAYERS WITH HEADPHONES, CALCULATORS, AND THERMOMETERS


U.S. Registration No.	1514572	Application Date	04/04/1988
Registration Date	11/29/1988	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1973/07/24 First Use In Commerce: 1973/07/24 EDUCATIONAL BOOKS, BINDERS, PRINTED FORMS, BUSINESS FORMS, TRADE JOURNALS, NOTEBOOKS, WRITING PAPER, ENVELOPES, PENS AND PENCILS		


U.S. Registration No.	1735461	Application Date	07/22/1991
Registration Date	11/24/1992	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1988/06/28 First Use In Commerce: 1988/06/28 health care services rendered through a health maintenance organization; namely, physician services, dental services, hospital services, home health care services, preventative health care services, health care services, medical lab services, counseling services in the field of family planning, mental health services and pharmacy services


U.S. Registration No.	1912003	Application Date	07/08/1994
Registration Date	08/15/1995	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1946/12/00 First Use In Commerce: 1946/12/00 association services, namely promoting the delivery of quality, cost-effective, health care		


U.S. Registration No.	1997329	Application Date	01/21/1994
Registration Date	08/27/1996	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1996/01/01 First Use In Commerce: 1996/01/01 underwriting, financing, administration, and brokerage of life insurance


U.S. Registration No.	2169141	Application Date	01/21/1997
Registration Date	06/30/1998	Foreign Priority Date	NONE
Word Mark	HMSA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 1965/01/00 First Use In Commerce: 1965/01/00 prepared financing and administration of medical, hospital and related health care services</p> <p>Class 042. First use: First Use: 1965/01/00 First Use In Commerce: 1965/01/00 comprehensive health care benefit programs, rendered through a health maintenance organization, namely, physician, dental, hospital, home health care, preventive health treatment, therapy, pharmacy, and ambulatory services</p>		


U.S. Registration No.	2202586	Application Date	04/01/1997
Registration Date	11/10/1998	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1996/10/00 First Use In Commerce: 1996/10/00 insurance, namely, underwriting in the field of workers compensation with or without a managed care component


U.S. Registration No.	2634534	Application Date	05/03/2001
Registration Date	10/15/2002	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark is used in the color blue		
Goods/Services	Class 016. First use: First Use: 1939/09/23 First Use In Commerce: 1949/11/05 newsletters pertaining to health and insurance		


U.S. Registration No.	3076555	Application Date	04/11/2005
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2005/02/01 First Use In Commerce: 2005/02/01 Offering consumer-driven health care plan, namely, underwriting, administration, financing, and maintenance of consumer-driven health care plans and defined contribution health care plans; debit card services, check cashing and check issuance, electronic debit transactions and electronic check processing transactions and providing financial information by electronic means via a global computer network, all of which are provided in connection with health care coverage plans


U.S. Registration No.	3172397	Application Date	03/31/2005
Registration Date	11/14/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1997/04/01 First Use In Commerce: 1997/04/01 Administration, financial management and maintenance of health savings accounts, medical savings accounts, and flexible spending accounts; insurance claims administration		


U.S. Registration No.	3132423	Application Date	07/06/2005
Registration Date	08/22/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 items of clothing and headgear, namely, t-shirts, shorts, sweatshirts, sweatpants, pullover tops, jackets, coats, socks, hats, caps and visors


U.S. Registration No.	3132425	Application Date	07/06/2005
Registration Date	08/22/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 all purpose athletic and sports bags, beach bags, carry-on bags, tote bags, luggage, briefcase-type portfolios and umbrellas		


U.S. Registration No.	3132571	Application Date	08/19/2005
Registration Date	08/22/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 021. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 coffee mugs and cups

U.S. Registration No.	3132573	Application Date	08/19/2005
Registration Date	08/22/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 pencils, pens, writing paper, envelopes, announcement cards, non-electric pencil sharpeners, drawing pads, paper identification tags, paper sheets, note pads, greeting cards, paperweights, stands for pencils and pens, calendars, diaries and stickers		

U.S. Registration No.	3219840	Application Date	03/09/2006
Registration Date	03/20/2007	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 playthings, namely, plastic toy animal figurines and stuffed animals

U.S. Registration No.	3288739	Application Date	03/31/2005
Registration Date	09/04/2007	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2006/11/30 First Use In Commerce: 2006/11/30 Banking and financial services, namely, checking and savings account services, electronic funds transfer, cash management and disbursement services, lending services, acceptance of deposits and loan payments, check cashing and check issuance, electronic payment services, providing financial information by electronic means, providing secure financial transactions in the nature of electronic cash transactions, electronic check processing transactions, trustee services, investment security services, certificates of deposits, asset management services, stored-value card services, smart card services, credit card services, all of which are provided in connection with health care coverage plans		

U.S. Registration No.	2161616	Application Date	02/07/1997
Registration Date	06/02/1998	Foreign Priority Date	NONE
Word Mark	BLUE CROSS AND BLUE SHIELD ASSOCIATION		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1982/00/00 First Use In Commerce: 1982/00/00 health care and wellness educational books, binders, printed forms, health care and wellness trade journals, health care and wellness newsletters, notebooks, pens and pencils

U.S. Registration No.	1744958	Application Date	04/17/1992
Registration Date	01/05/1993	Foreign Priority Date	NONE
Word Mark	BLUE CROSS AND BLUE SHIELD ASSOCIATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1982/12/00 First Use In Commerce: 1982/12/00 association services; namely, promoting the delivery of quality, cost effective health care by health care plans		

U.S. Registration No.	2150555	Application Date	02/07/1997
Registration Date	04/14/1998	Foreign Priority Date	NONE
Word Mark	BLUE CROSS AND BLUE SHIELD ASSOCIATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1982/00/00 First Use In Commerce: 1982/00/00 prepaid financing and administration of medical, hospital and related health care services Class 042. First use: First Use: 1982/00/00 First Use In Commerce: 1982/00/00 comprehensive health care benefit programs, rendered through a health maintenance organization, namely, physician, dental, hospital, home health care, prevent health treatment, therapy, pharmacy and ambulatory services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	A family of SHIELD word and design marks (registered and common-law), as further described in the Notice of Opposition.		
Goods/Services	A range of goods and services relating to insurance, health care, and other areas, as further described in the Notice of Opposition.		

Related Proceedings	91202144
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Attachments	71589371#TMSN.gif (1 page)(bytes) 71606403#TMSN.gif (1 page)(bytes) 78598882#TMSN.jpeg (1 page)(bytes) 78661842#TMSN.jpeg (1 page)(bytes) 78661852#TMSN.jpeg (1 page)(bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Garner K. Weng/
Name	Garner K. Weng
Date	11/07/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE: APPLICATION SERIAL NO. 85/004,633

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

v.

THE MCGRAW COMPANY,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer Blue Cross and Blue Shield Association, a not-for-profit membership-based corporation organized and existing under the laws of the State of Illinois, doing business at 225 North Michigan Avenue, Chicago, IL 60601-7680, brings this Opposition against Application Serial No. 85/004,633, filed by Applicant The McGraw Company, having an address of 3601 Haven Avenue, Menlo Park, CA 94025.

1. On information and belief, on April 1, 2010, The McGraw Company ("Applicant") filed Application Serial No. 85/004,633 (the "Application") under Section 1(a) of the Lanham Act. On information and belief, the Application was published in the U.S. Patent & Trademark Office's *Official Gazette* on May 10, 2011. The Application on its face seeks to cover: "Insurance services, namely, underwriting claims administration and agency services for casualty and watercraft insurance," in International Class 36. The Application describes its subject mark ("Applicant's Mark") by stating: "The mark consists of a shield, having three upward pointing apexes on the top and a single apex pointing downward on the bottom, with the inscription "McGraw Insurance Marine." The design codes assigned to Applicant's Mark note that Applicant's Mark contains "Shields or crests with letters, punctuation or inscriptions contained

therein or superimposed thereon." Additionally, the Application states that "[c]olor is not claimed as a feature of the mark," meaning it claims the mark in all colors and the mark is presumed to be used in all colors. In sum, Applicant's Mark specifically encompasses a blue shield as a central element; and Applicant in fact uses Applicant's Mark in the color blue.

2. Opposer Blue Cross and Blue Shield Association (the "Association") is a national association of 39 independent, community-based, and locally operated BLUE CROSS® and BLUE SHIELD® companies ("Member Plans"). The Association represents the nation's oldest and largest family of health benefits companies. For over 75 years, the Association (including through its predecessors in interest and its Member Plans and licensees) has provided millions of families with top-quality affordable health care plans. The Association's Member Plans currently provide health care plans for nearly 100 million people in the United States—or about 1 in 3 Americans—and offer health care plans in all 50 states, the District of Columbia, and in Puerto Rico. More than 90% of hospitals and 80% of physicians in the United States contract with the Association's Member Plans—more than any other insurer. The Association's Member Plans currently provide health care plans to more than half of the Fortune 500 companies and more than three-quarters of the Fortune 100 companies.

3. The BLUE CROSS and BLUE SHIELD brands are the most recognized in the health insurance industry in the United States—and among the most recognized in any industry. The Association is the owner of the BLUE SHIELD design marks—as well as the BLUE SHIELD word mark, the BLUE CROSS word and design marks, and other marks consisting of the image of a blue cross or the image of a blue shield (or both)—and licenses the use of various such marks to its Member Plans and other licensees for the provision of health and life insurance, health-care delivery services, financing access to health care, and other related goods and services. The Association (including through its predecessors in interest and its Member Plans and licensees) has been using these trademarks and service marks since at least as early as 1934 (BLUE CROSS) and 1939 (BLUE SHIELD).

4. Currently, in the United States alone, the Association owns more than 230 valid and subsisting U.S. federal trademark and service mark registrations. Many of its U.S. federal registrations have become incontestable under Section 15 of the Lanham Act. Additionally, the Association owns similar trademark and service mark registrations in more than 170 countries throughout the world. All these (along with numerous trade names and common-law marks) form a “family” of BLUE trade names, trademarks, and service marks (“Blue Marks”). Under the Lanham Act, the Association’s incontestable U.S. federal registrations are conclusive evidence of the Association’s exclusive right to use or authorize the use of the Blue Marks in commerce.

5. The Association (including through its Member Plans and licensees) has extensively used, advertised, and promoted the Blue Marks throughout the United States. For instance, in 2010 alone, total system-wide gross revenue was over approximately \$360 billion. The Association (including through its Member Plans and licensees) spends millions of dollars in advertising and promoting its marks, services, products, and image, thereby creating substantial goodwill in the marketplace. As a result, the general public recognizes the Blue Marks separately and collectively as identifying the Association and its Member Plans and licensees—and the quality services they render. The Blue Marks are an asset of incalculable value to the Association; and it has vigorously and successfully protected its marks. Moreover, at least as far back as 1977, federal district courts and other legal panels such as the World Intellectual Property Organization Uniform Dispute Resolution Policy Panel have expressly recognized the fame of the Blue Marks in designating the services of the Association (and its Member Plans and licensees) in the context of trademark disputes or litigation.

6. Among the Association’s marks are a wide range of marks consisting entirely or substantially of the words BLUE SHIELD, an image of a shield, or an image of a blue shield (or some combination of these) (the “Shield Marks”). Historically and through the present, the Shield Marks span a variety of differently configured shields; and historically and through the present, the Association (including through its predecessors in interest and its Member Plans

and licensees) has used and does use the Shield Marks in blue (including many different types and shades of blue) and in other colors. Some of the registrations of the Association's Shield Marks that are images of a shield specifically claim the color blue, and some are unrestricted as to color. Historically, before Applicant's adoption or use of Applicant's Mark, and through the present, the Association (including through its predecessors in interest and its Members Plans and licensees) has used and does use the Shield Marks in connection with, among other things, insurance, underwriting, and/or prepaid financing, including without limitation in areas such as health, medical, life, worker's compensation and disability. The Association's registrations of such Shield Marks include, without limitation, Registration Nos. 557,040; 562,430; 591,778; 617,304; 1,039,866; 1,045,586; 1,319,824; 1,319,825; 1,997,329; 2,016,013; 2,150,555; 2,169,141; 2,202,586; 2,634,534; 3,076,417; 3,076,555; and 3,169,932.

7. Applicant's Mark is confusingly similar to one or more of the Association's Shield Marks. Among other things, Applicant's Mark features a shield (presumed to encompass the color blue) as its only design element; Applicant in fact uses Applicant's Mark in the color blue; the goods and services listed in the Application are similar to, overlap with, or are otherwise the type to be seen as emanating from the same source under a single mark as those goods and services designated by the Association's Shield Marks; and the goods and services actually provided by Applicant under Applicant's Mark are similar to, overlap with, or are otherwise the type to be seen as emanating from the same source under a single mark as those goods and services designated by the Association's Shield Marks. Additionally, many members of the public view casualty insurance as encompassing worker's compensation and medical cost coverage. In sum, Applicant's Mark is therefore likely to confuse, cause mistake among, or deceive the relevant public into believing that Applicant is sponsored by, endorsed by, or in some manner related to the Association (or its Member Plans or licensees).

8. On information and belief, Applicant selected its mark in the Application, began using this mark, and continues to use this mark with full knowledge of the Association's Shield

Marks and with the intent to confuse, cause mistake among, and deceive the public into believing that Applicant's services are of the same high quality as or are in some way associated with the services of the Association (or its Member Plans or licensees).

9. The above-described use of Applicant's Mark is likely to impair and has impaired the distinctiveness of the Blue Marks, and in particular the Shield Marks, and their ability to identify and distinguish the goods and services of the Association—and has also harmed the reputation of the Association and these marks by associating them with Applicant.

10. Likewise, registration of Applicant's Mark, as described in the Application, will injure the Association by causing the relevant public to be confused, mistaken, or deceived to the detriment of the Association, by diluting the distinctive quality of the Association's famous Shield Marks, and by harming the reputation of the Association and its marks by associating them with Applicant.

11. For the reasons set forth in this Notice of Opposition, the Association believes that it will be damaged by the registration of Applicant's Mark in the Application. Accordingly, the Association requests and prays that the Application (and all parts of it) be denied registration.

12. In the alternative, should the Board find that the Application is entitled to registration in some form, under Section 18 of the Lanham Act, the Association requests that the Application be allowed registration only with the Application restricted as to color, by the addition of the following statement: "The mark is not and will not be used in the color blue (or any colorable imitation thereof)." In the second alternative, should the Board find that the Application is entitled to registration in some form, under Section 18 of the Lanham Act, the Association requests that the Application be allowed registration of its listed services only with the restrictions stated in the following description: "Insurance services, namely, underwriting claims administration and agency services for casualty and watercraft insurance (excluding health, life, disability, and workers' compensation insurance and excluding any underwriting of

medical, hospital, dental, or health care expenses, health care or defined contribution health care plans, and life insurance)."

The Association (through its counsel) hereby authorizes the requisite filing fee in the amount of \$300 to be charged to Hanson Bridgett LLP's U.S. Patent & Trademark Office Deposit Account No. 08-0630; and the Commissioner is further authorized to charge any deficiencies or other amounts due in connection with this filing to Deposit Account No. 08-0630.

Respectfully submitted,

BLUE CROSS AND BLUE SHIELD ASSOCIATION

By /s/ Garner K. Weng
Susan G. O'Neill, Esq.
Garner K. Weng, Esq.
Christopher S. Walters, Esq.
Attorneys for Opposer
Blue Cross and Blue Shield Association

Hanson Bridgett LLP
425 Market Street, 26th Floor
San Francisco, CA 94105
Tel.: (415) 777-3200
E-mail: soneill@hansonbridgett.com
E-mail: gweng@hansonbridgett.com
E-mail: cwalters@hansonbridgett.com

Date: November 7, 2011

CERTIFICATE OF SERVICE

I, Laura Prongos, hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION to U.S. Trademark Application Serial No. 85/004,633 was served on the parties listed below by mailing said copies on November 7, 2011 via U.S. First Class Mail, postage pre-paid to:

(1) Applicant

The McGraw Company
3601 Haven Avenue
Menlo Park, CA 94025

(2) Attorney of Record

Andrew P. Holland
Thoits, Love, Hershberger & McLean
285 Hamilton Avenue, Suite 300
Palo Alto, CA 94301

Dated: November 7, 2011

/s/ Laura Prongos

Laura Prongos